

REMARKS**I. Introduction**

The issues in the Office Action are as follows:

Claims 8, 9, and 11 are objected to for informalities; and

Claims 1 – 12, and 21 are rejected under 35 U.S.C. § 103(a).

Claims 13 – 20 have been withdrawn. In Claims 8, 9, and 11, the language “the method of claim 6” has been amended to read “the method of claim 7,” and claim 22 has been amended to depend from claim 21. These amendments have been made solely for the purpose of correcting typographical errors.

Claims 1, 7, 8, 10, 12, and 21 have been amended to more clearly claim the invention. Claims 23 – 28 have been added and support for these claims can be found on page 6 lines 1 – 27 of the specification. The specification has been amended to more clearly describe an embodiment of the invention. No new matter has been added, and claims 1 – 12 and 22 – 28 are currently pending.

II. Rejection of Claims 1-12

The Office Action rejects claims 1 – 12 as obvious in light of a U.S. Patent No. 5,914,068, and identifies the inventors as being Richard et al. The Applicants have assumed that the Examiner intended to cite Richard et al. U.S. Patent No. 5,924,068 (hereinafter *Richard*), and the following arguments reflect this assumption.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Office Action’s rejection must meet three basic criteria. First, the rejection must identify some suggestion or motivation, either in *Richard* itself or in the knowledge generally available to one of ordinary skill in the art, to modify *Richard*’s teachings. Second, there must be a reasonable expectation that the proposed modifications of *Richard* would be successful. Finally, *Richard*, so modified, must teach or suggest all the limitations of the rejected claims. *See* M.P.E.P. § 2143. Without conceding the first and second criteria, the

Applicants respectfully assert that *Richard*, even if modified as the Current Action proposes, does not teach or suggest all of the elements of the rejected claims, and thus the Current Action has failed to make a *prima facie* case.

Specifically, claim 1 recites a document retrieval system that includes “a data structure which stores said internal characteristics of said file and any said spoken characteristics of said file with said file in a memory,” and claim 7 recites a method of identifying documents that includes “creating metadata identifying said file using said internal characteristics and said spoken characteristics of said file.” The Applicants respectfully assert that *Richard*, even as modified, fails to teach or suggest these limitations. Therefore, the Applicants respectfully request that the rejection of claims 1 and 7 be withdrawn.

Claims 2 – 6 depend directly or indirectly from claim 1 and inherit all of its limitations. Claims 8 – 12 depend directly or indirectly from claim 7 and inherit all of its limitations. Therefore, claims 2 – 6 and 8 – 12 include limitations neither taught nor suggested by *Richard*, and the Applicants respectfully request that the rejections of claims 2 – 6 and 8 – 12 be withdrawn.

III. The Rejection of Claims 21 and 22

On page 5 of the Current Action, claims 1 – 12 appear to be rejected as obvious in light of Mishelevich, et al., U.S. Patent No. 6,434,547 (hereinafter *Mishelevich*). The Applicants have assumed that the Examiner intended the rejection to be directed towards claims 21 and 22, and the following arguments reflect this belief. If the Examiner intended this rejection to be directed to claims 1 – 12, the Applicants respectfully remind the Examiner that M.P.E.P. § 706.02(b) places the initial burden on the Examiner to clearly explain the rationale behind his rejection and to establish a *prima facie* case of obviousness.

Claim 21 recites a system for storing documents that includes “means for obtaining from a user for each said document to be stored, data tags pertaining to certain characteristics of said document, wherein said data tags are derived from information describing said document’s content and generated using character recognition, semantic processing, object

recognition, or voice recognition." The Applicants respectfully assert that *Mishelevich* does not teach means for obtaining from a user, data tags derived from information describing a document's content, and respectfully submit that *Mishelevich* instead teaches obtaining from a user actual document content. Therefore, *Mishelevich* does not teach or suggest every element of claim 21, and the Current Action has failed to establish a *prima facie* case for obviousness with respect to claim 21. The Applicants respectfully request that the Examiner withdraw the rejection of claim 21.

Claim 22 depends directly from claim 21, and thus inherits all of that claim's limitations. Therefore, claim 22 contains limitations neither taught nor suggested by *Mishelevich* and respectfully request that the Examiner withdraw the rejection of claim 22.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicants believe no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10003826-1 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV255077565US, in an envelope addressed to: MS Non-Fee Amendment, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on the date shown below.

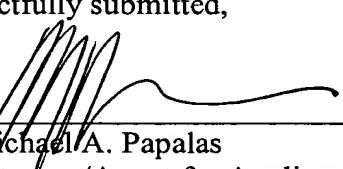
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Typed Name: John Pallivathukal

Signature: 

Respectfully submitted,

By


Michael A. Papalas
Attorney/Agent for Applicant(s)
Reg. No.: 40,381

Date: January 27, 2004

Telephone No. (214) 855-8186